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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,827	08/25/2003	Donald J. Rose	A8130.0141/P141	1344
24998	7590	03/22/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 2101 L Street, NW Washington, DC 20037			MENDOZA, MICHAEL G	
		ART UNIT		PAPER NUMBER
		3731		
DATE MAILED: 03/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/646,827	ROSE, DONALD J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael G. Mendoza	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 03 January 2005.

2a) This action is **FINAL**.                                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-3,5-7 and 9-14 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3,5-7 and 9-14 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments filed 3 January 2005 to claims 1-4 and 5-7 have been fully considered but they are not persuasive. The Applicant argues that Kammerer fails to teach a suture passer. In response to applicant's argument that Kammerer fails to teach a suture passer, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

2. The Applicant also argues that Kammerer fails to teach a crimped end with an acute bend.

3. Main Entry: **1crimp** 

Pronunciation: 'krimp

Function: *transitive verb*

Etymology: Dutch or Low German *krimpen* to shrivel; akin to Middle Dutch *crampe* hook, cramp

1 : to cause to become wavy, bent, or pinched: as a : to form (leather) into a desired shape b : to give (synthetic fibers) a curl or wave like that of natural fibers c : to pinch or

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press together (as the margins of a pie crust) in order to seal. (<http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=crimp>)

4. The loop of Kammerer is pinched together by rod 72.

5. Main Entry: **acute** 

Pronunciation: &-'kyüt

Function: *adjective*

Inflected Form(s): **acut·er**; **acut·est**

Etymology: Latin *acus*, past participle of *acuere* to sharpen, from *acus* needle; akin to Latin *acer* sharp -- more at EDGE

1 **a** (1) : characterized by sharpness or severity *<acute pain>* (2) : having a sudden onset, sharp rise, and short course *<acute disease>* **b** : lasting a short time *<acute experiments>*

2 : ending in a sharp point: as **a** : *being or forming an angle measuring less than 90 degrees* *<acute angle>*. (<http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=acute&x=15&y=12>)

6. The end of the loop of Kammerer is at an angle less than 90 degrees.

7. Applicant's arguments, see page 7, filed 3 January 2005, with respect to claim 9 have been fully considered and are persuasive. The 35 U.S.C. 102 rejection of claims 9, 11 and 12 has been withdrawn. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Fucci et al. 5697950 and Chan 6629984.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 5 depends on a cancelled claim.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

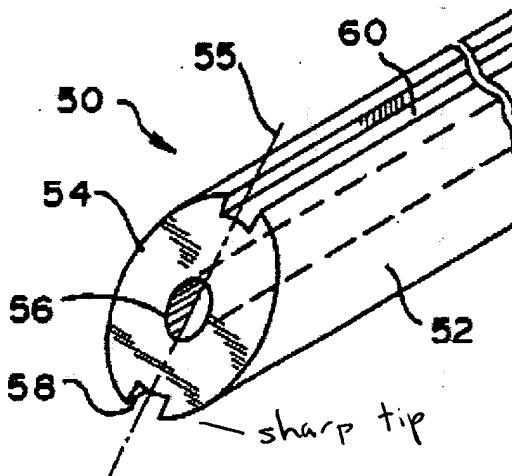
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Kammerer 5562684.

13. Kammerer teaches a suture passer comprising: a suture passing instrument having a cannulated shaft termination in a sharp tip; a strand of flexible metallic material formed into an elongated loop having a crimped end with an acute bend; wherein the flexible metallic material comprises nitinol (col. 6, lines 54-59); wherein the closure

comprises a shrink sleeve (Rod 70 is made of nitinol a (nickel-titanium mixture". Nickel-titanium mixture are heat shrinkable as evidenced by US Patent 5403331 to Chesterfield et al. See col. 4, lines 1-11); wherein the elongated loop has sufficient length to extend into a portal and out an accessory portal through a joint undergoing arthroscopic surgery.



14. Claims 1, 2, 6, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Chan 6629984.

15. Chan teaches a suture passer comprising: a suture passing instrument having a cannulated shaft terminating in a sharp tip; a strand of flexible metallic material formed into an elongated loop having a crimped end with an acute bend; wherein the flexible metallic material comprises nitinol (col. 26, lines 14-38); wherein the elongated loop has sufficient length to extend into a portal and out an accessory portal through a joint undergoing arthroscopic surgery; and wherein the cannulated shaft of the suture passing instrument has a helically shaped end portion (fig. 47).

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kammerer in view of Paudler 441497.

18. Kammerer teaches the suture passer of claim 6. It should be noted that Kammerer fails to specifically teach wherein the length comprises about 22 inches.

19. Paudler teaches a suture passer with a common length. Paudler discloses that the suture passer has a length of at least 9 inches. Paudler also teaches that the length of the passer depends on the site of surgery. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include the lengths of Paudler depending on where surgery is being performed (col. 4, lines 62-col. 5, line 7).

20. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fucci et al. 5697950 in view of Chan.

21. Fucci et al. teaches a method of securing tissue to bone comprising the steps of: installing a suture anchor with an attached suture strand in a portion of bone adjacent a section of tissue to be secured; deploying a loop formed of flexible metal wire from a distal end of a cannulated suture passing instrument; capturing the suture strand with the loop; and passing the captured suture strand through the tissue by retracting the

loop through the tissue. It should be noted that Fucci et al. fails to teach piercing the tissue with a sharp distal end of a cannulated suture passing instrument (col. 4, lines 3-29).

22. Chan teaches a method using a common step of piercing tissue with a sharp distal end of a cannulated suture passing instrument for piercing tissue. Therefore, it would have been obvious to one having ordinary skill in the art to include the step of piercing tissue with a suture passing instrument to allow the delivery of a suture through tissue (col. 3, lines 55-64).

23. As to claims 10 and 12, Fucci et al. teaches it is known for procedures involving suture anchors to be done with the use of portals. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a portal to complete the procedure of tying a suture to a suture anchor (col. 1, line 59- col. 2, line24).

24. As to claim 13, Fucci/Chan teaches the method of claim 9, further comprsing the step of forming a knot between the suture strand and a second suture strand also attached to the suture anchor (col. 1, lines 33-50).

### ***Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-44963. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



  
GLENN K. DAWSON  
PRIMARY EXAMINER

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